

MAY 22 2006

Commissioner for Patents
Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

The applicant then filed a Notice of Appeal on December 3, 2003. The applicant followed up the filing of the Notice of Appeal by filing a first Appeal Brief under 37 CFR 1.192 (old appeal rules) and a first amendment after a final rejection filed under 37 CFR 1.116(b) on June 3, 2004. In response to the first Appeal Brief and the first amendment,

Art Unit: 3676

the examiner sent the applicant a second advisory action and a first Notice of Defective Appeal Brief on September 17, 2004. The second advisory action indicated that the amendment would not be entered because it raised new issues that would require further consideration and/or search, and that it was not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal. The first Notice of Defective Appeal Brief indicated that: 1.) the status of the claims was not correct (37 CFR 1.192(c)(3)) due to the fact that claims 85-89 were not canceled because the first amendment was not entered; 2.) the status of the amendments filed subsequent to the final rejection was not correct (37 CFR 1.192(c)(4)) because the first amendment was not entered; 3.) the brief includes the statement that one or more claims stand or fall together (37 CFR 1.192(c)(7)), but it is not consistent with the applicant's arguments. The applicant said that the claims stand alone, but did not argue the claims individually or provide a separate heading for each issue, i.e. no separate argument was found for claim 101 (37 CFR 1.192(c)(8)); 4.) the brief does not contain a correct copy of the appealed claims (37 CFR 1.192(c)(9)) because Appendix II should be deleted; and 5.) finally, on page 16 of the Appeal Brief, line 4 Appellant argues "claims ...120 and 120...". Therefore, it is unclear which claims appellant intends to argue.

In response to the second advisory action a second amendment under 37 CFR 1.116(b) was filed on September 24, 2004. In regard to the second amendment, the record indicates that the second amendment was not entered, however no advisory action was mailed to applicant.

In response to the first Notice of Defective Appeal Brief, a second Appeal Brief filed under 37 CFR 1.192 (old appeal rules) and 37 CFR 41.37 (new appeal rules effective date September 13, 2004) was filed on October 18, 2004. In regard to the second Appeal Brief, the examiner did not act on said second Appeal Brief because a Supplemental or third Appeal Brief was filed on October 25, 2004 also under 37 CFR 1.192 (old appeal rules) and 37 CFR 41.37 (new appeal rules effective date September 13, 2004). Also, along with the second Appeal Brief, the appellant filed a third amendment under 37 CFR 1.116(b) on October 18, 2004. Once again, the record indicates that the third amendment was not entered, however no advisory action was mailed to applicant.

In regard to the third Appeal Brief, the applicant also filed a fourth amendment under 37 CFR 1.116(b) on October 25, 2004. In response to the third Appeal Brief, the examiner sent the applicant a second Notice of Defective Appeal Brief on March 17, 2005 because: 1.) the statement of the status of the claims (37 CFR 41.37(c)(1)(iii)) and 2.) the statement of the status of the amendments (37 CFR 41.37 (c)(1)(iv)) filed after final rejection was not correct; 3.) the brief does not contain a concise explanation of the subject matter defined in each of the independent claims, more specifically, the brief also did not include an explanation of every means plus function and step plus function under 35 USC 112 sixth paragraph and/or set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number and to the drawings, if any, by reference characters (37 CFR 41.37 (c)(1)(vii)), i.e. claim 6; and 4.) finally, the examiner indicated that the

Art Unit: 3676

brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37 (c)(1)(vii)). In regard to the fourth amendment, the examiner sent a third advisory action to applicant on November 17, 2004 indicating that this amendment would be entered for purposes of appeal.

In response to the second Notice of Defective Appeal Brief, a fourth Appeal Brief under 37 CFR 1.192 (old appeal rules) and 37 CFR 41.37 (new appeal rules effective date September 13, 2004) and a fifth amendment under 37 CFR 1.116(b) were filed on April 20, 2005. In response to the fourth Appeal Brief, the examiner sent a third Notice of Defective Appeal Brief on August 5, 2005 because: 1.) the brief does not contain a correct statement for the status of all of the claims (37 CFR 41.37(c)(1)(iii)); 2.) the statement for the status of the amendments after final was not correct (37 CFR 41.37(c)(1)(iv)); 3.) the brief also does not contain a concise explanation of the subject matter defined in each of the independent claims (37 CFR 41.37(c)(1)(v)); 4.) the claims appendix is not correct (37 CFR 41.37(c)(1)(viii)); and 5.) the brief does not contain the evidence appendix (37 CFR 41.37(c)(1)(ix)) or the related appeals and interference appendix (37 CFR 41.37(c)(1)(x)). Also in the third Notice of Defective Appeal Brief, the examiner pointed out that she incorrectly indicated that the fourth amendment filed on October 25, 2004 would be entered. The examiner indicated that the fourth amendment would not be entered because it was not in accordance with 37 CFR 41.33(b). In regard to the fifth amendment, the examiner did not enter the amendment and sent out a fourth advisory action that indicated the fifth amendment would not be entered because it was not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

Petitioner argues in the petition that: 1.) the first Appeal Brief was filed prior to the effective date for the new rules of September 13, 2004 and that the second, third, and fourth Appeal Briefs were filed in response to actions taken by the Examiner and were not filed as a "restatement" of an earlier Appeal and are therefore all clearly acceptable under 37 CFR 1.192; 2.) the statement found in either 37 CFR 1.192(c)(4) or 37 CFR 41.37(c)(1)(iii) that says "any amendment filed subsequent to the final rejection" does not mean all amendments; 3.) the brief is in conformance with 37 CFR 1.192(c)(5) and 37 CFR 41.37(c)(1)(v) because it does contain a concise explanation that is specific to all of the independent claims on appeal; 4.) the claim appendices are in compliance 37 CFR 1.192 because it is customary to provide two claims appendices when an amendment accompanies an Appeal Brief; and 5.) the brief does not need to include an Evidence Appendix or a Related Appeals and Interference Appendix because it was filed under 37 CFR 1.192. Thus, the petitioner is petitioning to have each Notification of Non-Compliant Appeal Brief withdrawn, to have the amendments filed after the final rejection to be entered, and to enter Applicant's fourth Appeal Brief filed on or about April 20, 2005.

Art Unit: 3676

In regard to the first Appeal Brief that was filed on June 3, 2004, it is agreed that all of the reasons set forth by the examiner indicating why the Appeal Brief was defective could have been addressed in an Examiner's Answer. However, the Appeal Brief was still defective because, even though it was not pointed out by the examiner, the brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number, and to the drawings, if any, by reference characters as set forth in 37 CFR 1.192(c)(6). Therefore, even though the Notice of Defective Appeal Brief did not indicate this deficiency, the Notice of Defective Appeal Brief was not sent out in error. The brief was defective for at least this last reason. Thus, the notice was appropriate.

In regard to the third Appeal Brief, it is agreed that the examiner was in error with respect to the statement of the status of the claims and the statement of the status of the amendments filed after final rejection. This was because the examiner should not have indicated that the fourth amendment would be entered for purposes of appeal. However, with respect to the third and fourth Appeal Brief, the examiner appears to have correctly indicated the other deficiencies in the briefs. It appears that many of the deficiencies pointed out by the examiner were due to the fact that it is not clear if the second, third, and fourth Appeal Briefs were meant to be filed under 37 CFR 1.192 (i.e. the old rules) or 37 CFR 41.37 (i.e. the new rules) because the briefs contain headings pertaining to the old rules i.e. heading VII Groupings of the Claims, and headings pertaining to the new rules, i.e. heading V Summary of the Claimed Subject Matter. The briefs also refer to both 37 CFR 1.192 and 37 CFR 41.37 throughout the briefs. Therefore, due to the fact that it is not clear what set of rules the appellant meant to file the briefs under, the examiner's reasons for holding the briefs defective is correct.

Finally, in regard to the Petitioner's first argument, it is agreed that the Appeal Briefs could have been filed under either 37 CFR 1.192 or 37 CFR 41.37 because the first Appeal Brief was filed prior to September 13, 2004. However, as stated above, it is not clear which set of rules the applicant intended the second, third, and fourth Appeal Briefs to be filed under. Thus, none of these Appeal Briefs will be entered.

In regard to the Petitioner's second argument that the statement found in either 37 CFR 1.192(c)(4) or 37 CFR 41.37(c)(1)(iii) that says "any amendment filed subsequent to the final rejection" does not mean all amendments, this statement is not agreed with. It does not state in the rule that only the amendments that affect the issues before the Board need to be listed. This appears to be Petitioner's own interpretation of the rules. The Director's interpretation of the rule is that the term "any" amendment does mean "all" amendments filed after a final rejection. Therefore, the examiner's position appears to be correct. Further, the applicant has filed all of the amendments after the filing of an Appeal Brief under 37 CFR 1.116(b). This is not proper. All amendments filed after the filing of an Appeal Brief need to be filed under 37 CFR 41.33(b). 37 CFR 41.33(b) states that amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form.

Art Unit: 3676

Therefore, since the amendments filed by the applicant are not limited to the items set forth in 37 CFR 41.33(b), they are not proper.

In regard to Petitioner's third argument that the briefs are in conformance with 37 CFR 1.192(c)(5) and 37 CFR 41.37(c)(1)(v) because they do contain a concise explanation that is specific to all of the independent claims on appeal, this argument is not agreed with. The first Appeal Brief does not contain a concise explanation of the claimed invention, referring to the specification by page and line number, and to the drawing, if any, by reference characters according to 37 CFR 1.192(c)(5). The first Appeal Brief does not contain any reference to the specification by page and line number. Therefore, this brief is not compliant for at least that reason. In regard to the second, third, and fourth briefs, as set forth above, it is first of all not clear what set of rules the applicant intended to file the briefs under. Secondly, at least the second and third briefs are not in compliance with either set of rules because they do not provide any references to the specification by page and line number. In regard to the fourth brief, while it does contain references to the specification by page and line number, it does not provide a concise summary for each independent claim. Thus, the briefs have been properly held defective.

In regard to petitioner's fourth argument that the claim appendices are in compliance with 37 CFR 1.192 because it is customary to provide two claims appendices when an amendment accompanies an Appeal Brief is moot. This argument is moot because, as stated above, the amendments were not submitted under the proper statute, i.e. 37 CFR 41.33(b), they were not in accordance with 37 CFR 41.33(b) and because they made changes to the claims other than merely rewriting claims into independent form to make them allowable. This argument is also moot because the Appeal Briefs filed have all been defective for the reasons set forth above and have therefore not been entered.

In regard to petitioner's fifth argument that the brief does not need to include an Evidence Appendix or a Related Appeals and Interference Appendix because it was filed under 37 CFR 1.192. If the Appeal Brief was filed under 37 CFR 1.192, the applicant is correct, and an Evidence and a Related Appeals and Interference Appendix is not necessary. However, due to the ambiguity of the Appeal Briefs as explained above, it is not clear if the second, third, and fourth Appeal Briefs were intended to be filed under 37 CFR 1.192 or 37 CFR 41.37. If the applicant filed the briefs under 37 CFR 41.37, the Evidence and Related Appeals and Interference Appendix are required. In conclusion, in regard to the Notifications of Non-Compliant Appeal Briefs, it has been determined that each Notification of Non-Compliant Appeal Brief issued by the Examiner was proper for either the reasons set forth by the Examiner, or the reasons pointed out above in this petition. Therefore, the petitioner's request to have each Notification withdrawn is hereby **DENIED**.

In regard to the entry of the amendments filed after the filing of an Appeal Brief, as pointed out above, the first amendment will not be entered for the reasons set forth in the advisory action, and the second through fifth amendments do not comply with 41.33(b). Thus, they will not be entered and the petitioner's request is hereby **DENIED**.


Art Unit: 3676

In regard to the entry of applicant's fourth Appeal Brief, it has been determined that said Appeal Brief is not in accordance with either 37 CFR 1.192 or 37 CFR 41.37 for either the reasons set forth by the Examiner, or the reasons pointed out above in this petition. Therefore, the fourth Appeal Brief will not be entered and the petitioner's request is hereby **DENIED**.

Finally, since the applicant has filed a fifth Appeal Brief on February 6, 2006 that is in accordance with 37 CFR 1.192, the fifth Appeal Brief will be entered. The application will be forwarded to the Primary Examiner so that the Examiner's Answer can be written and forwarded to the Board for a decision. Also, in regard to the second amendment filed on September 24, 2004 and the third amendment filed on October 18, 2004 that were not addressed by an Advisory Action as stated above, following this petition the examiner, in order to complete the record, will be sending the applicant an Advisory Action that will indicate the status of said amendments, consistent with the holdings in this decision.

SUMMARY: The petition is **DENIED**

Any questions regarding this decision should be directed to Brian Glessner at 571-272-6843.


Donald T. Hajec
Director
Patent Technology Center 3600
571-272-5150

BG/SNM: 05/09/06

SNM